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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,317	06/20/2003	Brian J. Cragun	ROC920030231US1	9777
46797 7590 02/15/2008 IBM CORPORATION, INTELLECTUAL PROPERTY LAW DEPT 917, BLDG. 006-1 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829			EXAMINER LIN, SHEW FEN	
			ART UNIT 2166	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/600,317

Applicant(s)

CRAGUN ET AL.

Examiner

SHEW-FEN LIN

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7, 9-15, 20-22 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 9-15, 20-22, and 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In view of the appeal brief filed on November 26, 2007, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claims 7, 9-15, 20-22, and 24-26 are pending.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 7 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 15 of copending Application No. **11/325,371**.

The following table shows the claim in Instant Application that are rejected by corresponding claim(s) in **11/325,371**.

Instant Application	Application 11/325,371
<p>7. A method for exchanging information between entities on a network comprising:</p> <p>installing an annotation management system on the network;</p> <p>identifying a plurality of annotatable data objects manipulated by a plurality of applications on the network; and</p> <p>providing a set of one or more configuration tools allowing a user to define an annotation structure containing one or more annotation fields and associate the annotation structure with at least one of the annotatable data objects,</p> <p>wherein the configuration tools further allow a user to define roles and associate annotation structures with combinations of roles and annotatable data objects.</p>	<p>12. A method for deploying an annotation management system on a network comprising:</p> <p>installing the annotation management system on the network;</p> <p>identifying an annotatable data item manipulated by at least one application on the network;</p> <p>defining at least one annotation structure comprising one or more annotation fields; and assigning the at least one annotation structure to the data item.</p> <p>15. The method of claim 12, further comprising:</p> <p>selecting a context for an annotation author; and wherein assigning the annotation structure to the data item further comprises associating the annotations structure with the selected role.</p>

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the same limitations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

Claims 9 and 10 are objected to because of the following informalities: Claim 9 improperly depends on claim 8, which has been canceled. Similar informality exists in claim 10. To expedite the prosecution of the application, claims 9 and 10 will be examined as dependent claims of claim 7.

Claim 12, line 2, the Examiner suggests using "a user" or "users" instead of "a users".

Appropriate correction is required.

Claim Rejections – 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20-22 and 24-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 20 recites the use of various components and elements that would be reasonably understood by one of ordinary skill in the art to mean software, software based component implementation, or an abstract concept based on software. Examples of components and

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concepts used in the claim such as an annotation database, an annotation server, configuration tools, and other terms that are interpreted to mean abstract concepts and software implementations. There are no definitive hardware or physical components associated with these examples in the claims or in the specification.

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best functional descriptive material *per se*.

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” Both types of “descriptive material” are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed Cir. 1994).

Merely claiming nonfunctional descriptive material, i.e., abstract ideas stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

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Regarding claims 21-22 and 24-26 depend from rejected claim 20, comprise the same deficiencies as those claims directly or indirectly by dependence, and are therefore rejected on the same basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 7, 9-15, 20-22, and 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Bays et al. (US Patent 6,519,603, hereinafter Bays).

As to claim 7, Bays discloses a method for exchanging information between entities on a network (Figs. 1, 2) comprising:

installing an annotation management system on the network (Figs. 1, 1A, col. 6, line 20 to col. 7, line 8);

identifying a plurality of annotatable data objects manipulated by a plurality of applications on the network (an annotatable data item, i.e. the subsection of database material

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that can be annotated, and database material may be text, graphics, spreadsheets, relational tables or any other material, Figs. 4-5, col. 2, lines 13-21, col. 5, lines 31-33); and

providing a set of one or more configuration tools allowing a user to define an annotation structure containing one or more annotation fields (Figs. 3A-3D, col. 2, lines 38-46, col. 7, lines 43-50) and associate the annotation structure with at least one of the annotatable data objects (Figs. 3A-3D, col. 9, lines 43-49) wherein the configuration tools further allow a user to define roles and associate annotation structures with combinations of roles and annotatable data objects (context reads on role, col. 5, lines 25-31, col. 8, lines 26-35, col. 9, lines 43-45).

As to claim 9, Bays discloses the method of claim 8 [sic] wherein the configuration tools provide one or more graphical user interface screens for associating one or more roles with a user (col. 3, lines 10-14, col. 7, lines 9-14, col. 8, lines 26-35, col. 9, lines 47-49).

As to claim 10, Bays discloses the method of claim 8 [sic] wherein the configuration tools provide one or more graphical user interface screens for associating one or more users with a role (col. 3, lines 10-14, col. 7, lines 9-14, col. 8, lines 26-35, col. 9, lines 47-49).

As to claim 11, Bays discloses the method of claim 7, wherein the configuration tools allow a user to specify one or more filters specifying how annotation fields contained in an annotation structure can be manipulated based on user roles (Figs. 3A-3D, col. 9, lines 43-49, col. 11, lines 25-33).

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As to claim 12, Bays discloses the method of claim 7, wherein the configuration tools: allow a users to specify one or more annotation field groups (col. 9, lines 11-30); and allow annotation field groups to be added to annotation structures (col. 9, lines 35-41).

As to claim 13, Bays discloses the method of claim 7, wherein the configuration tools allow a user to associate one or more transforms with an annotation structure, the transforms for use in converting the annotation structure into a graphical user interface (Fig. 2, col. 3, lines 20-33).

As to claim 14, Bays discloses the method of claim 7, wherein the configuration tools allow a user to associate an annotation structure with annotatable data objects associated with more than one data source (col. 2, lines 10-29, col. 5, lines 31-49, col. 9, lines 42-49).

As to claim 15, Bays discloses the method of claim 7, wherein the configuration tools allows annotatable sub-objects of data objects to be associated with annotation structures (col. 2, lines 13-29)

As to claim 20, Bays a system for managing annotations for one or more different type data sources manipulated by a plurality of different type applications (col. 2, lines 10-29), comprising:

an annotation database for storing annotations separately from the data sources associated with the annotations (Fig. 1A, col. 2, lines 29-37);

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a set of annotatable data object points defining portions of the data sources associated with the annotations described by the associated annotations (col. 2, lines 29-37, col.3, lines 48-67);

an annotation server configured to receive requests to access annotations for one or more of the annotatable data object points issued by the one or more of the applications running on the client computer (Fig. 1A, 4-8, col. 3, line 59 to col. 4, line 17, col. 7, lines 43-50) and generate a graphical user interface screen, based on an annotation structure associated with the one or more of the annotatable data object points, for creating or viewing annotations for the one or more annotatable data object points (Figs. 2, 3A-3D, col. 5, lines 20-30, col. 7, lines 9-14); and

one or more configuration tools allowing a user to define annotation structures and associate annotation structures with one or more of the annotatable data object points (Figs. 3A-3D, col. 9, lines 7-49), wherein the configuration tools allow users to associate one or more annotation structures with at least one of: one or more combinations of annotatable data object points and roles; or one or more combinations of annotatable data object points and users (Fig. 3A, col. 3, lines 16-20, col. 5, lines 25-30, col. 9, lines 42-49, col. 11, lines 31-33).

As to claim 21, is directed to a system claim carrying instructions for performing the method of claim 14 and is rejected along the same rationale.

As to claim 22, is directed to a system claim carrying instructions for performing the method of claim 9 and is rejected along the same rationale.

As to claim 24, is directed to a system claim carrying instructions for performing the method of claim 13 and is rejected along the same rationale.

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As to claim 25, Bays discloses further comprising a plurality of configuration files (Fig. 3C, template reads on configuration file) and wherein the configure tools allow a user to navigate and modify one or more of the configuration files (Fig. 3C, col. 9, lines 56-60, col. 10, lines 5-16).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 26 are rejected under 35 U.S.C. 103(a) as being obvious over Bays as applied to claim 25 above, and further in view of Rubin et al. (US Patent Publication 2002/0099552, hereinafter Rubin).

As to **claim 26**, Bays does not explicitly disclose wherein the configuration files are extensible markup language (XML) files.

Rubin discloses wherein the configuration files are extensible markup language (XML) files (paragraph 59, 84).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Bays's disclosure to include extensible markup language (XML) files as taught by Rubin for the purpose of using XML, various devices may then work with the properties without requiring access to the structure of the second example (paragraph 84, Rubin). The skilled artisan would have been motivated to improve the invention of Bays per the above such that template file can be accessed by different users/applications.

Response to Remarks

Applicant's arguments have been fully and carefully considered but are moot in view of the new ground(s) of rejection. Refer to the corresponding sections of the claim analysis for details.

Related Prior Arts

The following list of prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Allam, Scott Gerald et al., US 20020116420 A1, "Method and apparatus for displaying and viewing electronic information".
- Gupta; Anoop et al., US 6484156 B1 , "Accessing annotations across multiple target media streams".

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- Yung; Robert, US 5548739 A, "Method and apparatus for rapidly retrieving data from a physically addressed data storage structure using address page crossing predictive annotations".

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shew-Fen Lin whose telephone number is 571-272-2672. The examiner can normally be reached on 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

February 13, 2008

Shew-Fen Lin
Patent Examiner
Art Unit 2166



HOSAIN ALAM
SUPERVISORY PATENT EXAMINER